

Applicant: Rauno Rantanen
Application No.: 10/501,624
Response to Office action mailed Jan. 3, 2007
Response filed March 20, 2007

Remarks

Claims 21, 22, 23, and 33–35 remain pending in the application. In the Office action dated Jan. 3, 2007, claims 21 and 33 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claim 21 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Tooker* (US 5,417,797) in view of *Reckziegel* (US 4,984,949) and *Lemke DE 37 14226A1*. Claim 33 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Tooker* in view of *Reckziegel*. Claims 22 and 23 stand allowed.

The courtesy extended to applicant's counsel by Examiner Tadesse in the telephone interview conducted Mar. 7, 2007, is acknowledged with appreciation. During the interview, applicant's counsel presented evidence set forth below that the specification implicitly discloses a paper or board making machine, and that the specification—by incorporating FI Patent Application 991498 by reference—explicitly discloses a board machine. Secondly, applicant's counsel discussed how the claimed rod does not perform a metering function as shown in *Tooker*, overcoming the examiner's basis for finding *Tooker* to be analogous art. Thirdly, applicant discussed how the paper or board web is a positive structural limitation. Lastly, there was a discussion of the very different structure of the bookbinding art references in comparison to the claimed device, making an analogy between a claimed surgical instrument and the possibility of finding something that looks similar among woodworking tools, clay modeling tools, or vegetable peeling tools. This example clearly indicates a serious burden the examiner has when nonanalogous art is applied, to show the reasonableness of looking to such art, i.e. showing more than a mere surface similarity between the nonanalogous art and applicant's claimed invention.

Applicant proposed to incorporate material from FI 991498 to provide explicit support for the preamble of claims 21 and 33. The examiner requested the foregoing arguments be made of record with cites to portions of corresponding publication WO0102098.

New claims 33, 34 have been added wherein the apparatus for feeding a treating agent is located in a forming section of the paper making machine. Claims 33–34 are based on Paragraph [0057] “...in a situation in which treatment is carried out in a forming section.”

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New matter objection

From the application:

[0003] “ The web to be treated, in turn, can be a *paper web, a board web* or a plastic film. ”
[Emphasis added.]

[0010] “Metso Paper, Inc.’s *FI Patent Application 991498*, which is incorporated by reference herein, discloses an arrangement for spreading a treating agent on a moving surface.” [Emphasis added]. This disclosure provides incorporation by reference of FI 991498 which corresponds to WO0102098.

[0031] “The apparatus operates such that a treating agent is fed into the feed chamber 12 from the inlet opening 13a of the feed chamber 12 situated on one side of the body housing 11 of the feed apparatus 10. Depending on the application of use, the treating agent can be water, size, coating colour or another liquid material used for treating *the web that is being produced.*” [Emphasis added.] Thus the application specification explicitly states that the web (which may be a paper or board web see [0003] above) is being produced, implicitly disclosing a machine for producing said web.

WO0102098 corresponds to FI 991498 and explicitly sets forth a board machine:

In paperboard manufacture in particular, it would be preferable to provide such a method and a device to spread surface size on the surface of the web, which makes it possible to apply a sufficient amount of size on the web's surface at a considerably higher velocity than before, but which would be cost-effective enough also *when used in board machines* with low production volumes.(*WO0102098 p. 2, lines 2–7, emphasis added*)

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The invention can also be used to apply a coating or size on a web, when it is in a semi-wet state, in other words, before the final drying. In that case, feeding can be carried out ~~[[by]]~~ on the drying part, ~~the pressing part or the web part~~ *of the machine*, for example, directly to the nip, belt or roll or directly to the surface of the web. (*WO0102098 p. 4, lines 27–32, emphasis added; corrections added to conform the quoted text to the actual Finnish text, based on communication with Finnish attorney*)

Note quotes from WO0102098 have been proofed against the Finnish text of FI 991498 by the assignee's representative in Finland, and where necessary, the quotes have been marked up to show how the WO text differs from that Finnish text.

The specification has been amended to explicitly include the paper or board machine based on the foregoing implicit and explicit disclosure of a paper or board machine.

Argument from the USPTO patent database.

Forming section of a papermaking machine occurs 9 times in the title of a patent, and 144 time in the specification of a patent, in the searchable USPTO database. The patent database provides a reasonable basis for applicant's contention that a person of ordinary skill in the art would find the term "machine" is implicit within the term "forming section" in the context of applicants specification.

Tooker is not analogous art

A rejection of applicant's claims over a plurality of references must make a *prima facie* case that the references in combination teach or make obvious applicant's claimed invention. In this context it is not permissible to pick and choose from the prior art to construct applicant's invention according to the blueprint of applicant's disclosure. Rather, the motivation in expectation of success must be found in the prior references or a convincing

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argument must be made of why a person of ordinary skill in the art would know to make applicant's claimed combination. A part of any such convincing argument when applied to non-analogous art must meet the test set forth by the examiner in the last Office action mailed Jan. 3, 2007, p. 7, lines 12–19:

In response to applicant's argument that Tooker is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be *reasonably pertinent to the particular problem with which the applicant was concerned*, in order to be relied upon as a basis for rejection of the claimed invention. See In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). *In this case, Tooker discloses a feeding apparatus with inclined surface and a roller to apply a metered amount of coating material, which is pertinent to applicant's feed apparatus evening out the coating material.* [Emphasis added.]

However the last sentence above admits that Tooker discloses metering with a *roller*, whereas in applicant's claimed invention, the amount of coating is controlled by the nozzle plate, not the applicator rod. Further, the function of evening-out is explained by Paragraph [0046] of the specification: "The evening-out apparatus illustrated in Fig. 4 comprises a plate forming an inclined surface 110 and having an upper end 112 which extends to the bottom surface of a nozzle plate 18, and a lower end, i.e. a trailing edge 111 which rests against the outer surface of a cylindrical applicator rod 140." The function of "evening-out" is thus performed at least in part if not wholly by the plate 110. This evening-out function is not even argued by the examiner to be performed by Tooker. Thus the examiner has failed to show any problem with which applicant was concerned within applicant's claimed invention, to which Tooker is reasonably pertinent.

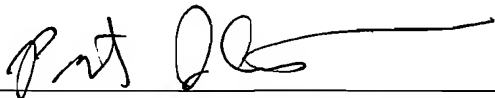
As set forth in applicant's remarks as part of the Amendment filed on Nov. 24, 2006, under Discussion of the applied references (pp. 6–8, incorporated herein by reference), all the applied references to book binding are very different and do not deal with the particular problems associated with coating of a paperboard web in a papermaking machine.

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Applicant believes that no new matter has been added by this amendment.

Applicant submits that the claims, as amended, are in condition for allowance.
Favorable action thereon is respectfully solicited.

Respectfully submitted,



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April 3, 2007 (12:32pm)